

REMARKS

Claims 12 and 15-18 are currently pending in the application. Claim 12 is amended. No new matter is presented. The above amendments and the following remarks are considered by Applicants to overcome each rejection raised by the Examiner and to place the application in condition for allowance. An early Notice of Allowance is therefore requested.

The Examiner requests disclosure of a device combining the ConforCor 2 and a laser scanning microscope. Applicants do so by the Information Disclosure Statement filed herewith. It should be noted, however, that Weisshart et al. (*Current Pharmaceutical Biotechnology*, 2004) (“Weisshart”) provides a full disclosure of the device.

Claims 12 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 12 is amended to more clearly recite the features of the claimed invention. No new matter is presented. In view of the amendments to claim 12, Applicants request the withdrawal of the rejection of claims 12 and 15-18 under 35 U.S.C. 112.

Claims 12 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Carl Zeiss’ platform combining ConfoCor2 and a laser scanning microscope, referred to by Weisshart. Applicants respectfully disagree.

The first paragraph of Weisshart states: “The demand for measuring correlation functions within a cellular environment was met by Carl Zeiss in the year 2000 by combining ConfoCor 2 and LSM (laser scanning microscope) detection modules in one integrated platform.” (Weisshart at 1.) Carl Zeiss did combine ConfoCor 2 and LSM detection modules in one integrated platform (hereinafter the “platform”).

The platform was not in public use or on sale in the United States, however, until May 23, 2000. (See Declaration of Dr. Klaus Weisshart ¶¶5-6.) On that date, Carl Zeiss, Inc., a subsidiary of Carl Zeiss Jena GmbH, sold the platform to Boehringer Ingelheim Research and Development, whose offices are located at 175 Briar Ridge Road, Ridgefield, Connecticut 06877, U.S.A. (*Id.*) On May 26, 2000, Carl Zeiss, Inc. purchased the platform from Carl

Zeiss Jena GmbH. (*Id.*) Then, on August 10, 2000, Carl Zeiss Jena GmbH generated invoice number 2040118607 for delivery of the platform to Carl Zeiss, Inc. (*Id.*)

Approximately three months earlier, on February 22, 2000, Applicants filed German Application 100 08 594.6 (the “German Application”). The instant application properly claims priority to the German Application. (*See* Substitute Specification filed 11/6/01 at 1.) Thus, the instant application’s effective filing date is February 22, 2000. (*See* MPEP 706.02.)

Because the platform was not on sale or in public use until May 23, 2000, and the effective filing date of the instant application is February 22, 2000, the platform was not in public use or on sale in the United States more than one year prior to the effective filing date of the instant application. Accordingly, the 102(b) rejection based on the public use or sale of the platform is not proper. Applicants therefore request withdrawal of the rejection of claims 12 and 15-18.

For the reasons presented above, claims 12, and 15-18, all the claims pending in the application, are believed by Applicants to define patentable subject matter and should be passed to issue at the earliest possible time. A Notice of Allowance is requested.

Respectfully submitted,

Eugene LeDonne
Reg. No. 35,930

REED SMITH LLP
599 Lexington Avenue
29th Floor
New York, NY 10022
(P) 212-521-5400

Attorney for Applicant